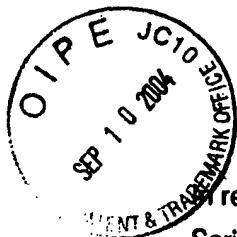


09-13-04

AF/2875
IPW



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: John A. Rushing

Serial No: 09/433,761

Group No.: 2875

Filed: 11-4-99

Examiner: Anabel Ton

For: Diffuse Lighting Arrangement

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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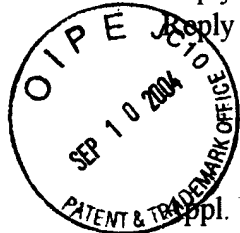
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Reply Brief dated September 9, 2004

Reply to Office action of July 13, 2004



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.

: 09/433,761

Applicant

: John A. Rushing

Filed

: November 4, 1999

Title

: Diffuse Lighting Arrangement

TC/A.U.

: 2875

Examiner

: Anabel, Ton

REPLY BRIEF

Honorable Commissioner of Patents

P.O. Box 1450

Alexandria, Virginia 22153

Dear Sir:

REMARKS

Appellant first of all points out that the Examiner's Reply was not received until 10 months after filing of the Appeal Brief.

In Section 1208, Examiner's Answer, of the M.P.E.P. under the rules presently in effect, it is stated:

"The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner."

Appellant wishes to make the extreme lateness of the Examiner's Reply of record herein, inasmuch as Appellant could never take 10 months to accomplish anything since the rules only

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provide for a maximum non-extendable period of 6 months.

Reviewing the Examiner's Reply, it appears to merely comprise a rehash of the rejections set forth in the Final Rejection, therefore leaving Appellant at a loss as to why the Examiner needed 10 months to prepare the Examiner's Reply.

It is also noted that the rules are changing on the 13th of September, 2004, in the area of Appellate practice to "expedite" prosecution. However, it is not believed that elimination of the time limit within which an Examiner must reply will serve to expedite prosecution, but merely extend prosecution time, as has happened in the instant Appeal.

Nonetheless, Appellant timely responds to the Examiner's Reply as follows.

The Board here is referred to the extensive arguments presented in response to the Final Rejection as well as to the lengthy argument, supported by case law citations, presented in the Appeal Brief.

Further, Appellant states as follows:

Nowhere does the cited prior art disclose the structure as claimed by Appellant, alone or in combination.

The differences from the prior art may be considered minor by the Examiner. Such changes cannot be held against the claims of the subject application, based merely on opinion.

Here see Structural Rubber Prod. Co., v. Park Rubber Co., 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984):

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if, ... the differences between the claims and the prior art references are

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"insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art."

In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984):

"The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification."

Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103."

Hartness International, Inc., v. Simplimatic Engineering Co., 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987):

"In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed."

Further by the taking of bits and pieces from various pieces of art which include no motivation, direction or suggestion to perform such combination, it is clear that the Examiner has attempted an improper hindsight reconstruction of the Appellant's structure. The mere fact that various structures and embodiments thereof may appear in various and asundry pieces of prior art, as the Examiner opines, does not preclude patentability of the present invention, on its face, due to lack of motivation to dissect the teachings of the prior art, rather than taking the teachings as a whole, as required by law, leaving the teachings of the prior art destroyed for the intended purpose thereof, only to fill a mold provided by Appellant in a poor attempt, at best, to negative patentability of the present invention, over the prior art cited.

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Here see Interconnect Planning Corp., v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985):

"It is error to reconstruct the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination."

Uniroyal, Inc., v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988):

(2) "When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."

Rockwell International Corp v. United States, 147 F.3d 1358, 47 U.S.P.Q.2d 1027, 1032 (Fed. Cir. 1998):

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."

Ex parte Levengood, 28 U.S.P.Q.2d 1300, 1301 (B.P.A.I. 1993):

"...an Examiner's mere assertion that one of ordinary skill in the relevant art would have been able to arrive at a claimed invention because he had the necessary skills to carry out the requisite process steps is an inappropriate standard for obviousness."

In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986):

"There was no suggestion in the prior art to provide the applicant with the motivation to design the valve assembly so that it would be removable as a unit. The Board argued that, if the reference had followed the "common practice" of attaching the valve stem to the valve structure, the valve assembly would be removable as a unit. The only way the Board could have arrived at its conclusion was through hindsight analysis by reading into the art applicant's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the

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subject matter as a whole would have been obvious at the time the invention was made.”

In re Mercier, 515 F.2d 1161, 185 U.S.P.Q. 774 (C.C.C.P.A.):

“As distinguished from a disclosure of equivalents, the disclosure of a known relationship does nothing more than teach that it would have been obvious to try, which is insufficient under 35 U.S.C. §103.”

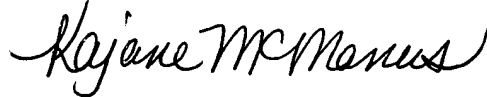
Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988):

“A proper combination of references requires the presence of a teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one of ordinary skill in the art to make the combination. The mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious.”

Accordingly, the Examiner’s machinations in twisting and bending the prior art into

Appellant’s mold cannot be seen to be founded on a solid evidentiary base and must therefore fall.

Respectfully submitted,



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